

REMARKS

This Application has been carefully reviewed in light of the Non-Final Office Action mailed February 4, 2008. At the time of the Office Action, Claims 1-4, 15-23, 25-27, 40-42 and 52-71 were pending and were rejected in this Application. Claims 5-14, 24, 28-39 and 43-51 were previously cancelled without prejudice or disclaimer. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 1-4, 15-18, 40-42, 52-54, 63-67 and 69-71 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,929,238 issued to Baum ("Baum").

Claims 20-23 and 25-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of U.S. Patent No. 4,863,072 issued to Perler ("Perler").

Claims 19 and 68 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baum in view of U.S. Patent No. 4,032,118 issued to Phillips ("Phillips"). Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

When determining whether a claim is obvious, the Examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, it is well settled that obviousness requires at least a suggestion of all the features in a claim. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, "*there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*" *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

With regard to independent claims 1, 54, and 63, the Office Action cites to the rotatable connector element 16 of Baum as anticipating the recited introduction section. Applicant

submits that the rotatable connector element 16 does not disclose the recited introduction section. Additionally, claims 1, 54, and 63 describe that the introduction section is larger than an intermediate section between the first and second ends of the first column. Element 16 of Baum is not described as being larger than an intermediate section between first and second ends of first column 12. Finally, the introduction section described in claims 1, 54, and 63 is recited as commencing at the first end of the first column, such that the introduction section is thereby necessarily spaced away from the second end of the first column having an orifice for delivering implant material therethrough. Element 16 of Baum is not located at the end of column 12 spaced away from the end having an orifice for delivering implant material; rather, element 16 is located at the end of column 12 having an orifice (e.g., discharge tube 24) for delivering implant material therethrough. For at least the reasons presented above, Baum does not at least suggest all of the elements of claims 1, 54, and 63, and therefore cannot render obvious claims 1, 54, and 63. Applicant respectfully submits that claims 1, 54, and 63 are in condition for allowance, and requests withdrawal of the rejection.

Claims 2-4, 15-18, 40-42, 52-53, 64-67 and 69-71 depend either directly or indirectly from one of claims 1, 54, or 63. Applicant repeats and hereby incorporates the above comments with respect to claims 1, 54, and 63. For at least the reasons state above, Applicant submits that claims 2-4, 15-18, 40-42, 52-53, 64-67 and 69-71 are in condition for allowance and requests withdrawal of the rejection.

For at least the reasons discussed above, Applicant submits that Claims 19, 20-23, 25-27 and 68 depend from Claims that are in condition for allowance. Applicant further submits that the combination of Baum and Perler fails to teach every claimed element of Claims 20-23 and 25-27. For instance, Baum and Perler, alone or in combination, fail to teach an introduction section as recited. With respect to Claims 19 and 68, Applicant further submits that the combination of Baum and Phillips also fails to teach every claimed element of Claims 19 and 68. For instance, Baum and Phillips fail to teach, alone or in combination, an introduction section as recited.

Information Disclosure Statement

Applicant encloses an Information Disclosure Statement and PTO Form 1449, with copies of the references for the Examiner's review and consideration.

CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$180 for the IDS, and any additional fees or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.358.5925.

Respectfully submitted
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8/1/08

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Enclosure: 1) Information Disclosure Statement and PTO Form 1449